

REMARKS

Claims 1-22 are presented for further consideration. Claims 1, 7, 15 and 16 have been amended and new claims 19-22 are presented for the first time.

Claim Rejection - 35 USC § 112

Applicant offers the following in support for claims 11-14 meeting the requirements of 35 USC § 112.

At page 1 of the description, the following definitions are set forth:

As used herein, the term “process-ready cloves” refers to washed and skinned cloves of garlic.

As used herein, the term “garlic bits” or “bits” refers to the form of garlic that results from cutting process-ready cloves into smaller pieces of generally uniform thickness.

As used herein with reference to bitterness and strength of garlic flavor in garlic bits, the term “reduced” means less than existed prior to garlic bits having been subjected to a reducing process.

As used herein, “garlic pieces” and “pieces” refer to garlic bits of reduced strength of garlic flavor and bitterness that have been fried.

Thus, using the definitions specifically set out in the description at page 1, “garlic pieces” are “garlic bits” that have been fried, which can be expanded to read: washed and skinned cloves of garlic cut into smaller pieces of generally uniform thickness that have reduced bitterness and garlic flavor and have been fried.

The longstanding rule of claim interpretation, which has been recently confirmed, is that an applicant is entitled to define terms and have those terms used in construing the claims. See Texas Digital Systems, Inc. v. Telegenix, Inc., 308 F.3d 1193, 64 USPQ2d 1812 (Fed. Cir. 2002.) (“In short, the presumption in favor of a dictionary definition will be overcome where the patentee, acting as his or her own lexicographer, has clearly set forth an

explicit definition of the term different from its ordinary meaning.”); Phillips v. AWH Corp., 415 F.3d 1303 (Fed Cir. 2005) (“We cannot look at the ordinary meaning of the term ... in a vacuum. Rather, we must look at the ordinary meaning in the context of the written description . . .”).

Thus, by using the definitions given by Applicant in the context of the description, as the law instructs, claim 11 necessarily has the following limitations:

generally uniformly thick cuts of garlic from washed and skinned garlic cloves (garlic bits);

such cuts processed to have reduced (but not eliminated) bitterness and garlic flavor;

such cuts fried until crispy.

The basis of the term “bits” comes directly from the definitions of “garlic pieces” and “garlic bits” set forth on page 1 of the description, *to wit*:

“As used herein, ‘garlic pieces’ and ‘pieces’ refer to garlic bits of reduced strength of garlic flavor and bitterness that have been fried.” “As used herein, the term ‘garlic bits’ or ‘bits’ refers to the form of garlic that results from cutting process-ready cloves into smaller pieces of generally uniform thickness.”

Although claim 11 may contain only two words, it meets all the requirements of 35 USC § 112 when the words are given the full meaning that Applicant has carefully set forth in the description. It was never Applicant’s intent to claim pieces of garlic where a dictionary meaning was to be given to the word “pieces.”

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Claim Rejection - 35 USC § 102 (Meiji) Claim 11

Meiji is directed to a process that results in a product from which the odor of garlic is completely eliminated. Applicant's invention, on the other hand, is a product that adds garlic flavor to foods. While Applicant reduces the bitterness and strong garlic flavor from its product to render it palatable, it would be contrary to Applicant's objects to eliminate the flavor (odor) altogether. As explained on pages 1 and 2 of the description:

"The present invention provides ready-to-use garlic in the form of palatable, crispy, roasted-flavor pieces that can conveniently be stored and dispensed from a shaker. The garlic pieces of the present invention can be dispensed directly from a shaker onto food, either during or after its preparation, to lend the savory flavor of garlic.

When introduced into mashed potatoes, for example, the mashed potatoes are immediately imbued with the roasted flavor of toasted garlic with the added feature of lightly crunchy morsels. The same is true for salads, meat, poultry, fish and any other food with which garlic flavoring is desired." (Underlining added.)

Thus, Applicant's invention, as set forth in claim 11 (applying the definitions in the description), is distinguished over Meiji by having a reduced, not eliminated, flavor of garlic from cuts of garlic cloves and not whole cloves. While claim 11 may not specify the size of the garlic pieces, it does specify that whole garlic cloves are cut up prior to the process to reduce the garlic flavor, which is a significant distinction over Meiji for all of the reasons set out above.

To anticipate a claim, the reference must teach every element of the claim. MPEP 2131. "A claim is anticipated only if each and every element, as set forth in the claim, is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. Of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir, 1989).

Because Meiji does not teach every element of claim 11 (when the proper definition of “garlic pieces” is applied), the rejection under 102 must be withdrawn.

Claim Rejection - 35 USC § 103 (Meiji in view of Rombauer) Claims 1-3, 5, 7-9, 11-17

Applicant’s invention teaches a sliced, fried and dried garlic product for table use that has generally uniform reduced bitterness and garlic flavor. None of the cited references recognize such a product, or even the desirability of such a product. As revealed by a careful reading of the cited references, the *only* reference to, acknowledgement of, discussion of, or description of such a product is *Applicant’s disclosure*.

Summary of Cited References

Meiji teaches a process resulting in the complete deodorization of whole garlic cloves to preserves nutritive properties and form a health supplement. Nothing in Meiji relates to a food flavor enhancer or a process for making the same. Meiji teaches away from Applicant’s invention by teaching: (1) a product with complete garlic deodorization (Applicant teaches a garlic flavoring product); (and2) that the garlic odor is removed while the garlic is in cloves and not slices of cloves.

The blanching taught by Meiji is for a whole different purpose and reaches a different result from the blanching in Applicant’s process. As stated by Meiji: “The unpleasant odor of garlic is completely eliminated . . .” Meiji is interested in achieving a product having the touted health benefits of garlic without any garlic taste. To maintain its nutritive effect while eliminating the

garlic odor completely, Meiji teaches that the cells of the garlic must be preserved. Meiji claims to have achieved its objective by processing whole garlic cloves under certain non-atmospheric pressure conditions.

By contrast, Applicant teaches a product that can be conveniently stored and used to add the flavor of garlic to food. In order to achieve uniformity, Applicant teaches that the garlic cloves must be cut into generally uniformly thick pieces before it is processed to reduce (but not eliminate) the bitterness and strong flavor.

To apply Applicant's step of slicing or dicing the garlic cloves before the flavor-eliminating step of Meiji would cause the very destruction of the cells that Meiji's invention is designed to preserve. Thus, not only does Meiji not teach Applicant's claimed process or product, it is not reasonable to contemplate modifying Meiji by adding the step of cutting the garlic cloves before eliminating the odor. Such a modification would defeat Meiji's object of preserving the cells and Applicant's invention would not be achieved in any event, as there would be no flavor of garlic remaining. The result would be non-flavored garlic with greatly reduced nutritive value.

Rombauer, in teaching traditional cooking with garlic, also teaches *away* from Applicant's invention. Rombauer teaches that whole cloves (not slices) of garlic are blanched before being simmered in butter and minced (sliced). Blanching the clove while whole produces an uneven strength of garlic flavor throughout the clove. This lack of uniformity is not a problem for Rombauer's process, which then minces the blanched cloves and adds them

directly to a sauce. But where the slices are to be fried and later applied to food as a seasoning, as taught by Applicant, uniformity is a highly desired characteristic. Furthermore, Rombauer does not teach a fried and dried form of garlic that can be added to food from a shaker, much as one would add salt or pepper.

Sakamoto is directed to “Furnace Construction for Drying Garlic.” Like Meiji, Sakamoto is concerned with the health benefits of garlic and, in particular, with the loss of volatile elements of garlic during baking. Sakamoto explains that prior art baking methods and apparatus cause scratches on the surface of the garlic cloves and these scratches result in a substantial loss of volatile elements. The entire patent is devoted to working with whole cloves of garlic in a way that does not permit the escape of volatile elements. Nothing could be more contrary to Sakamoto than slicing the garlic cloves before processing, as taught by Applicant.

Argument

While it may be true that the individual steps of blanching garlic, slicing garlic and frying garlic are all individually well known in the art, that is not sufficient to support a rejection of obviousness where Applicant teaches a novel combination of those steps which results in a novel product. There is no suggestion in the cited art of “garlic pieces” (fried and dried, generally uniformly thick, crispy cuts of garlic with reduced flavor and bitterness) or the sequence of steps taught by Applicant to produce “garlic pieces.”

Without a suggestion from the prior art, an obviousness rejection is

impermissible as explained in Ex Parte Levengood, 28 USPQ2d 1300, 1301-1302 (TTAB 1993) (“In this case, however, the only suggestion of the isolated teachings of the applied reference improperly stems from the Applicant’s disclosure and not from the applied prior art. In In Re Ehrreich, 590 F.2d 902, 200 USPQ 504 (CCPA 1979), at best, the Examiner’s comments regarding obviousness amount to assertion that one of ordinary skill in the relevant art would have been able to arrive at Applicant’s invention because he had the necessary skills to carry out the requisite steps. This is an inappropriate standard for obviousness. See Orthokinetics, Inc. v. Safe Travel Chairs, Inc., 806, F.2d 1565, 1 USPQ2d 1801 (Fed. Cir. 1986). That which is within the capabilities of one skilled in the art is not synonymous with obviousness. [Citations omitted]. That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic, sound or scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of reference with the claimed invention.”

Applicant has shown that the prior art actually teaches away from its invention (complete deodorization; blanching before cutting) so it is doubly true that nothing in the prior art suggests the combination suggested by the Examiner. It is well established that in the absence of a suggestion from the *prior art*, as opposed to Applicant’s disclosure, a combination is not a proper grounds for a 103 rejection. In re Fritch, 23 USPQ2d 1780 (CAFC 1992) (“Obviousness cannot be established by combining the teachings of the prior

art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious ‘modification’ of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Wilson and Hendrix [Meiji and Sakamoto] fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner and endorsed by the Board. Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court had previously stated that ‘[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’”

Not only is there no incentive in the prior art to make the combination, there is every disincentive—keep the cloves whole and unscratched during blanching.

The rejection under 103 should be withdrawn for all of the reasons given above.

The Examiner Has Failed To Make A *Prima Facie* Showing Of Obviousness Under § 103

Applicant respectfully submits that the Examiner has failed to make a *prima facie* showing of obviousness under § 103.

The Examiner bears the initial burden of *factually supporting* any *prima facie* conclusion of obviousness. In re Deuel, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995).; In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992); MPEP 2142.

To establish a *prima facie* case of obviousness, all three of the following basic criteria must be met.

(1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings (MPEP 2143.01);

(2) There must be a reasonable expectation of success (MPEP 2143.02); and

(3) The prior art reference (or references when combined) must teach or suggest all the claim limitations (MPEP 2143.03).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143-§ 2143.03 for decisions pertinent to each of these criteria.

If the Examiner, at the initial stage, does not produce a *prima facie* case of unpatentability, then, without more, Applicant is entitled to grant of the patent. In re Oetiker, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

In the current Office Action, the Examiner has attempted to supply the claim elements missing from Meiji with the teachings from Rombauer and Sakamoto. Office Action, pages 2-3.

The claim elements not disclosed in Meiji cannot be supplied by Rombauer or Sakamoto without inspiration from Applicant and would not result in Applicant's invention even if the combination were made. Thus, criteria (1), (2) and (3) *all* fail (no recognition whatsoever of the end product and no success as the result is not the claimed invention).

For all of the reasons given above, the rejection under 35 U.S.C. § 103 should be withdrawn

Conclusion

Applicant has created a novel garlic product and a novel process for making that product. Nowhere in the prior art is it recognized that garlic can be processed so as to produce crispy shreds of garlic having reduced but uniform garlic flavor which can be dispensed from a shaker onto food, either during its preparation or at the time of consumption, to add a zesty garlic flavor.

This novel product which no prior art reference has revealed, has been claimed in several different ways, as has been the novel process by which it is made.

In describing the invention, Applicant has, for purposes of precision, defined the terms "garlic bits," "garlic pieces" and "reduced flavor." Having precisely defined those terms, Applicant is entitled under the law to have its

definitions used in interpreting the claims.


When the correct definitions, as set forth in the description, are applied to the terms of the claims, the claims include limitations which carefully distinguish Applicant's invention over the prior art and overcome any rejections under 35 U.S.C. § 102 or 35 U.S.C. § 103.

Furthermore, Applicant's definitions, when applied to the claims, satisfy 35 U.S.C. § 112.

For all of the reasons set forth above, Applicant respectfully submits that the claims be allowed.

Respectfully submitted,

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